

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 15, 17, 19, 26, 27, 29, 30 and 33-34 are pending after entry of the amendments set forth herein.

Claims 15-32 were examined. Claims 15-32 were rejected.

Please replace claims 15, 17, 26 and 27 with the clean version provided above. Claims 16, 18, 20-25, 28, 31 and 32 have been canceled, without prejudice, above. New claims 33-34 have been submitted for consideration thereof by the Examiner.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**"

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

In the Office Action of November 4, 2002, the Examiner rejected claims 15, 26 and 29 under 35 U.S.C. Section 102(b) as being clearly anticipated by Takahashi et al. (U.S. Patent No. 4,767,142). The Examiner asserted that the claim language reciting that the currently claimed device is adapted to fix a portion of the heart was considered to be a statement of intended use and was not considered to be sufficient to define over Takahashi, which the Examiner interpreted to disclose structure identical to that being claimed.

Applicant respectfully disagrees. In a case decided by the Court of Customs and Patent Appeals (*In re Venezia*, 189 USPQ 149, 151-152) the Court stated, in its opinion, that the language "adapted to be fitted over" imparted a structural limitation to the sleeve that was being claimed. The Court reasoned that each sleeve was so structured or dimensioned that it could be fitted over the insulating jacket of a cable. Similar reasoning was provided regarding the recitations of "adapted to be affixed" and "adapted to be positioned" recitations. In keeping with this case law, Applicant respectfully submits that the language "adapted to fix a portion of a beating heart" imparts structural limitation to the claimed instrument which patentably differentiates over what is disclosed by Takahashi et al. For example, in

order to be “adapted to fix a portion of a beating heart”, the instrument must be made of biocompatible, medical grade materials (e.g., see specification, page 9, last two lines). Takahashi et al. discloses a vacuum-forceps adapted for attaching to a silicon wafer as used in the semiconductor manufacturing arts. As such, Takahashi et al. would not use medical grade materials for producing the vacuum-forceps, as such would be completely unnecessary and unnecessarily costly. Further, the forceps of Takahashi et al. are not adapted to fix a portion of a beating heart, but are adapted to grasp and pick up a silicon wafer, using suction, as clearly described in the disclosure of Takahashi et al. The structure of the forceps of Takahashi et al. would not be suitable for fixing a portion of a beating heart.

Still further, it is respectfully submitted that Takahashi et al. does not disclose (or inherently possess) each and every feature recited in the rejected claims. For example, claim 15 recites at least one suction port and at least one suction line, wherein a suction aperture interconnects the suction port and suction line. A suction aperture, as recited, can be seen in Applicant’s Figs. 6 and 7, reference numeral 26, as well as in Fig. 3, interconnecting port 2 with suction line 4, for example. In contrast, Takahashi et al. discloses a suction-forceps device for grasping a silicon wafer (e.g., see Fig. 2). The device includes an adsorptive plate made of polychlorotrifluoroethylene (PCTFE) which has a recessed portion 35 therein. A ventilation tube 33 connects directly to the recessed portion 35 as clearly shown in the cross-sectional view of Fig. 4. Even if the recessed portion 35 could be accurately construed to be a port, which Applicant respectfully submits that it cannot be, it is submitted that Takahashi et al. clearly fails to disclose an aperture as claimed, since the claimed aperture interconnects a port and a suction line, and Takahashi et al. discloses no such aperture. Rather, Takahashi et al. directly connects the ventilation tube 33 to the recessed portion 35.

For at least the above reasons, it is respectfully submitted that claims 15, 26 and 29 patentably define over the disclosure of Takahashi et al. In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 15, 26 and 29 under 35 U.S.C. Section 102(b) as being clearly anticipated by Takahashi et al. (U.S. Patent No. 4,767,142), as being clearly improper.

Claims 15-32 were rejected under 35 U.S.C. Section 102(e) as being clearly anticipated by Borst et al., U.S. Patent No. 5,836,311. In response thereto, Applicant is submitting a copy of an affidavit pursuant to 37 CFR 1.131 by Charles S. Taylor, which was submitted in U.S. Application Serial No. 08/603,328 (now U.S. Patent No. 5,727,569) to which the present application claims priority under 35

U.S.C. Section 120. The Affidavit was originally submitted to overcome a rejection of the claims in the earlier application under 35 U.S.C. Section 102(a) in view of an article by Borst et al. entitled "Coronary Artery Bypass Grafting Without Cardiopulmonary Bypass and Without Interruption of Native Coronary Flow Using a Novel Anastomosis Site Restraining Device" and dated May, 1996. Because the Affidavit is by the present inventor of the claims recited in this application, and because the Affidavit shows the completed construction of an instrument claimed, prior to the filing date of Borst et al., U.S. Patent No. 5,836,311, Application respectfully submits that the present ground of rejection is inappropriate and should be withdrawn.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 15, 17, 19, 26, 27 and 29 (claims 16, 18, 20-25, 28 and 31-32 having been canceled without prejudice) under 35 U.S.C. Section 102(e) as being clearly anticipated by Borst et al., U.S. Patent No. 5,836,311, as being clearly inappropriate. Additionally, it is respectfully submitted that claims 33 and 34 are allowable by virtue of their dependency from claim 26.

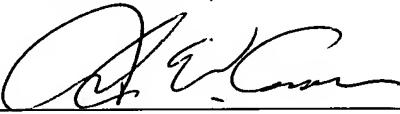
Conclusion

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number GUID-003CON3.

Respectfully submitted,
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Date: February 6, 2003

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Claim 15 was amended above as follows:

15. (Amended) An instrument adapted to fix a portion of a beating part by applying a negative pressure thereto, said instrument comprising:

a [first] member adapted to contact the portion of the beating heart, said [first] member having at least one suction port adapted to deliver the negative pressure to the portion of the beating heart, at least one suction line for connecting said at least one suction port to a source of negative pressure, and a suction aperture interconnecting each said at least one suction port with said at least one suction line, wherein each said suction aperture has a cross-sectional area substantially smaller than a cross-sectional area of said suction port with which it connects.

Claim 17 was amended above as follows:

17. (Amended) The instrument of claim 15, said [first] member having a plurality of said suction ports, each said suction port being interconnected to said at least one suction line by a respective one of said suction apertures.

Claim 26 was amended above as follows:

26. (Amended) A suction member [adapted to be mounted at a distal end of an instrument, said instrument adapted to fix] for fixing a portion of a beating part by applying a negative pressure through said suction member, said suction member comprising [at least one elongate] a body having a surface configured to engage the portion of the beating heart, at least one suction port having a distal opening through said surface and adapted to engage the surface of the beating heart, [and] a suction aperture fluidly connected to each said suction port, and a suction conduit passing within said body and fluidly

connecting with each said suction aperture, said suction conduit being in fluid communication with a source of negative pressure [vacuum line].

Claim 27 was amended above as follows:

27. (Amended) The suction member of claim 26, wherein [each] said [elongate] body contains a plurality of said suction ports and a plurality of said suction apertures respectively connecting said suction ports to said suction conduit, wherein each said suction aperture has a cross-sectional area that is smaller than a cross-sectional area of said port to which it connects, wherein said cross-sectional area of said port is measured where it opens to said surface.